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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/277,189	03/26/1999	EDWARD G. MCLAUGHLIN	048657-5001	3185

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EXAMINER

POINVIL, FRANTZY

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 01/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/277,189

Applicant(s)

MCLAUGHLIN ET AL.

Examiner

Frantzy Poinvil

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1936 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. Claims 1-30 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Lamm (US Patent No. 6,078,907) in view of Kolling et al (US Patent No. 5,963,925), Walker and PR NewsWire as found in the prior Office action.

Applicant argues that the Examiner has used impermissible Hindsight.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Furthermore, Kolling teaches a system and method for presenting an electronic statement to a consumer. The system and method comprise receiving a plurality of bills at a biller service provider 106 (column 7, lines 44-48) from a plurality of billers. The plurality of bills is scanned (column 10, lines 7-20) and data therein are extracted and validated using a template (column 8, lines 52-67 and column 11) for generating an electronic statement, which is transmitted to a consumer financial institution (CFI 130) (column 13, lines 33-52) for presentment to a consumer.

Lamm teaches a bill presentment system which allows a consumer to register or subscribe for receiving electronic-based bills (column 9, lines 37-57). Bills are received from a

plurality of billers and scanned and identified. (Column 10, lines 18-63). Unnecessary information are also omitted and billing information are extracted using a template. Applicant is directed to column 10, lines 40-63). The bills are accessed by the consumer from an electronic post office. See column 12, lines 16-44 of Lamm.

Walker teaches improvements in bill presentment systems. Walker states that "customers may receive bills directly from the biller or from a third party such as a bill consolidator or a financial institution. Billers must be able to accept enrollment information from many sources, validate the information and change the way the customer's bill is processed and delivered. Walker further states "when a customer signs up for electronic delivery, their next bill is automatically re-routed from the paper to the electronic process. If desired, this module can also send a paper bill and an electronic bill for a specified period. Walker further states that in a thick consolidator or outsource model, customers access all their bills at a consolidator's web site and the biller merely sends the bill data to the consolidator. Customers gain the ability to pay many bills at or web site, but the biller loses direct contact with customers.

The PR NewsWire relates to a National Processing Co. (NPC) that processes customer bills for Washington Water Power's national specialty billing and information services enterprise, Avista Advantage.

Thus, as can be clearly, seen, each of the individual references relate to obtaining a plurality of bills from a plurality of billers for presentment to one or more customers. The bills are transferred to the customers or are remotely accessed by the customers at a consolidator's site. When combining the references, it is noted that customers must be enrolled in order to access the electronic bills from one or more billers. Thus, the combination of Lamm, Kolling et

al, Walker and the PR NewsWire clearly suggests the claimed invention as noted above and as indicated in the prior Office action and the Examiner has not based the rejection on improper hindsight.

Applicant's representative then argues that Walker and the PR NewsWire do not satisfy the enablement provision or 35 USC Section 112 first paragraph.

In response, the Examiner has not based the rejection solely on the Walker and/or the PR NewsWire references. The rejection is based on a combination of references whereby Kolling and Lamm provide the computer means and associated hardware to perform the teachings noted with Walker and the PR NewsWire.

Applicant's representative then argues that the references teach away from one another.

In response, the Examiner respectfully disagrees. Each of the references attempts to solve the same problem and when combined result in applicant's invention.

Applicant's representative then argues that the references do not teach or suggest each and every limitation.

In response,

As per claims 2-3, 5, 11, 18, 20 and 26. Lamm teaches removing unnecessary material from a received paper bill. Column 10, lines 40-63. The references in combination teach forwarding inserts from the received paper bill to the customer, receiving a payment instruction, drafting a payment on an account from the customer to pay the bill and sending the payment to

the biller that originates the bill. Applicant is referred to pages 3 and 4 of Walker, column 9, lines 14-49 of Kolling et al.

As per claims 4, 12, 19 and 27, note column 29, line 62 to column 30, line 19 of Kolling et al.

As per claims 6 and 21, see column 6, lines 3-16 of Lamm.

As per claims 7 and 22, see column 10, lines 6-21 of Kolling et al.

As per claims 8 and 23, the combined references teach presenting an electronic image of a paper bill upon receipt of a request from a customer.

As per claims 10, 14, 15, 25 and 30, different billers would have different identifiers for the purpose of tracking different bills from different billers and for transmitting the correct bills to the appropriate or related customers.

As per claims 28 and 29 see the arguments noted above.

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (703) 305-9779. The examiner can normally be reached on Monday-Thursday 7:00AM-5:30PM.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9326 Before Final rejection and (703) 872-9327 for After Final rejection. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

FP

January 8, 2004

Frantzy Poinvil
FRANTZY POINVIL
FAX RECEPTIONIST
AU 3628